

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICIA L. GARDNER, WAYNE L. RUBY,
NORMA L. BISHOP, and ROBERT R. STEPHENS

Appeal 2007-0548
Application 10/815,408
Technology Center 3600

Decided: July 24, 2007

Before LORA M. GREEN, NANCY J. LINCK, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

LINCK, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a 35 U.S.C. § 134 appeal in the above-referenced case.¹
We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

¹ The application was filed April 1, 2004. The real party in interest is Idaho Research Foundation, Inc.

STATEMENT OF THE CASE

The subject invention is an “infant holder for circumcision and other medical procedures that helps an infant lie in a natural, comfortable position with legs flexed at the hips and knees and rotated at the hips, while still allowing the doctor good access to the infant’s groin area.” (Specification (hereafter “Spec.”) 1.)

The claimed subject matter is reflected in the following representative claims:

1. An infant holder, comprising a body having a recess therein configured to support an infant's torso and legs such that the thighs extend out from the torso at an angle in the range of 70°-120° and incline relative to the torso at an angle in the range of 20°-50°.

5. The holder of Claim 1, wherein the recess comprises a first recess configured to support the infant's torso and second recesses adjoining the first recess, the second recesses configured to support the infant's legs.

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as anticipated by Bowman, U.S. Patent No. 5,329,934 (issued July 19, 1994).

Claims 5-11 are rejected under 35 U.S.C. § 103(a) based on Bowman and Powell, U.S. Patent No. 2,700,381 (issued Jan. 25, 1955).

DISCUSSION

The patentability of the claims in this case turns on the meaning of “recess . . . configured to support an infant’s torso and legs such that the thighs extend out from the torso” at a particular angle (claims 1-5), or language drawn to that limitation (claims 6-11).

The Examiner's position is that the support can be indirect. (Answer 6.) In the Examiner's words, a "torso pad" which "supports the infant's torso . . . must inherently support the infant's legs as the infant's legs are attached to the infant's torso." (*Id.*)

The Appellants respond: "Claim 1 requires a recess configured to support an infant's torso *and* legs. The clear implication is that Claim 1 requires direct support for both the torso and the legs – indirectly supporting the legs through the torso does not meet the plain language of the claim. A contrary reading of Claim 1 would render nugatory the recitation of support for both the infant's torso and the infant's legs." (Reply Br. 3.)

The Examiner further argues "the supporting of the infant's torso and legs is [an] intended use of the claimed invention that does not patentably distinguish the claimed invention from Bowman." (Answer 6.)

In response, Appellants point out "whether the noted claim language is deemed structural or functional, it is not merely a recitation of intended use. The phrase 'configured to support an infant's torso and legs' modifies 'recess' – the recess in the body must have this characteristic to meet the limitations of Claim 1." (Reply Br. 4.)

We agree with the Appellants that the language of claim 1 should be interpreted to require direct support of the legs, not just the torso. While we give claim language its "broadest reasonable interpretation," *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed.Cir.1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed.Cir.1985) (en banc), that interpretation must be consistent with the teachings in the Specification to be "reasonable." *See id.*

In this case, Appellants claim an infant support that permits the infant's legs to be at certain claimed angles during surgery. In order for that

to be possible, the infant's legs would require direct support by the recess. Further, as Appellants argue, any other reading of the claim would in effect write the language "support an infant's . . . legs" out of the claim.

With respect to the "intended use" argument, we also agree with Appellants' position. Appellants chose to limit the scope of their claimed "recess" by requiring it to have a configuration capable of supporting both an infant's torso and legs. Thus, their claimed "recess" must be interpreted in a way so as to be capable of supporting an infant's torso *and* legs. *See In re Stencel*, 828 F.2d 751, 755, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986)).

The § 102(b) Rejection

Given our interpretation of claim 1, we turn to its rejection based on Bowman. Bowman discloses "a medical patient restraint device for additional comfort while restraining patients during surgical procedures such as circumcision of infants." (Bowman, col. 1, ll. 49-52.) Bowman discloses support members for the head and torso but is silent with respect to support for the legs.

In addition to the Examiner's arguments based on a claim interpretation different than ours (*see supra*), the Examiner relies upon Figures 1 and 2 to show Bowman's recess directly supports the infant's legs. Figures 1 and 2 are reproduced in the Appendix (p. 8). The Examiner argues "the infant's lower leg portion actually contacts the block 50 to prevent the infant from extending his/her legs downwardly during the medical procedure." (Answer 6 (with no supporting citation).) Further, according to the Examiner, Figure 1 "shows . . . the infant's legs are supported by the recess formed in the torso pad 40 when the infant is lying in the infant

holder.” (Answer 6 (again without citing any disclosure in Bowman other than Fig. 2).)

Appellants respond: “It is not possible to tell from the plan view of Bowman’s Fig. 1 whether or not the infant’s legs are supported by or even touching any part of torso pad 40. However, it is clear from the section view of Fig. 2 . . . that the infant’s legs are not supported by torso pad 40. Indeed, the infant’s legs do not even touch torso pad 40.” (Reply Br. 3.) With respect to the Examiner’s argument based on support block 50, Appellants respond

support block 50 in Bowman . . . is not configured to nor does it support the infant’s legs. Bowman Figs. 1 and 2 show lower torso support block 50 in contact with the infant’s buttocks. Even if it is assumed for purposes of argument only that the infant’s “lower leg portion” contacts lower torso support block 50 . . . , any such contact cannot reasonably be deemed support for the infant’s legs in general, and more specifically, support for the infant’s legs at the claimed range of angles.

(Reply Br. 3.)

We agree with Appellants that Figures 1 and 2 do not support the Examiner’s position. As Appellants note, Figure 1 does not disclose the position of the infant’s legs in relation to the torso pad, and Figure 2 shows support block 50 touching the infant’s buttocks (referred to by Bowman as the “lower torso”) rather than supporting the legs. In this regard, Bowman teaches support block 50 “may be useful in a surgical procedure such as circumcision of an infant to comfortably support *the lower torso* when the physician operates.” (Col. 4, ll. 63-66 (emphasis added).)

Given the above, we conclude the Examiner has not made a prima facie case of anticipation with respect to claim 1. Claims 2-4 depend upon claim 1. Thus, we reverse the § 102(b) rejection of claims 1-4.

The § 103(a) Rejection Based on Bowman and Powell

The Examiner's § 103(a) rejection of claims 5-11 is based on the combination of Bowman and Powell. Like claims 1-4, each of these claims requires support for the infant's legs at a given angle relative to the torso.

Powell is an older reference that discloses a surgical table with "a shallow depression or cavity for the reception of an infant." (Col. 1, ll. 16-19.) When strapped onto the table, the infant's legs are supported but are straight rather than bent, as required by the angular limitations in each claim. (See Powell, FIGs. 1 and 2.) Powell does not disclose one or more recesses configured to support an infant's torso *and* legs "such that the thighs extend out from the torso" at a particular angle. Thus, Powell does not cure the deficiencies of Bowman, leaving a substantial gap between Appellants' claimed invention and the prior art. With respect to a § 103 rejection, a gap in the prior art teachings cannot not be "so great as to render the [claim] nonobvious to one reasonably skilled in the art." *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). For the reasons given with respect to claims 1-4, we also reverse the § 103(a) rejection of claims 1-5.

CONCLUSION

In summary, we reverse the rejections of claims 1-4 under § 102(b) and claims 5-11 under § 103(a).

REVERSED

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APPENDIX

U.S. Patent

July 19, 1994

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